

REMARKS/ARGUMENTS

The Examiner is thanked for the telephone interview of February 28, 2005. It is believed that substantial progress was made during that interview. It is Applicants' understanding that with minor amendments, claims 47 through 57 and 73-77 are allowable. While method claims 58-72 and 78 to 80 were also discussed during that interview, Applicants understand that the Examiner maintains his rejection of those claims.

Claims 47, 52, 60, 67 and 74 have been amended for formal purposes and to correct typographical errors in accordance with the suggestions in the Office Action and the discussion during the telephone interview of February 28, 2005. Applicants are introducing new claim 81 which is based on preexisting claims and does not introduce new matter or raise new issues. The fee for the additional claim is enclosed.

Turning to the details of the Office Action, during the February 28, 2005 interview the priority issue set forth in Paragraph No. 1 of the Office Action was discussed. It appears that the issue arises only because of certain designations in the Declaration. The Examiner indicated that he would check with the Special Programs Examiner concerning this issue but acknowledged that Applicants are entitled to the benefit of their priority date.

In Paragraph No. 2 of the Office Action, the Examiner objected to certain informalities. This objection was discussed during the interview and the Examiner advised that Applicants should refer the Examiner to the bottom of page 6 of the English language translation of the application which resolves this issue. Accordingly, the objection should be withdrawn.

In Paragraph No. 3, the Examiner set forth certain claim objections. Claim 47 has been amended so it is now consistent with claim 52 and the typographical error appearing

in claim 67, line 5, has been corrected. Accordingly, those claim objections should be withdrawn.

Paragraph No. 5 sets forth a rejection based on 35 U.S.C. §112. As discussed during the February 28, 2005 interview, the rejection has essentially been addressed by addressing the objection set forth above. Again, the Examiner's attention is invited to the lower part of page 6 of the specification (English translation) wherein the expression M_n is referred to. The Examiner acknowledged that this designation is recognized by those of ordinary skill in the art to refer to a number average molecular weight. However, out of an abundance of caution, Applicants have amended the above-identified claims to specifically refer to M_n .

Paragraph No. 6 of the Office Action was also discussed during the February 28, 2005 interview. The Examiner indicated that he will withdraw the rejection set forth in that paragraph. In this regard, the Examiner is referred to the original claims of the PCT application which he indicated he did not have available to him at the time he issued the last Office Action.

Starting in Paragraph No. 7, the Examiner set forth the rejection under 35 U.S.C. §103. It should be noted that claims 47 to 57 and 73 to 77 directed to the multicomponent coating and/or adhesive material were not rejected based on prior art.

Claims 58 to 62, 64 to 68, 78 and 80 were rejected under 35 U.S.C. §103(a) as unpatentable over Rossitto in view of Helmeke et al. and Yang et al. Applicants incorporate by reference their previously submitted comments and/or arguments regarding these references.

Rossitto refers to a thermoplastic/thermoset adhesive which comprises an at least partially reacted blend of one or more isocyanate-reactive compounds and an isocyanate compound having specific properties.

In sharp contrast to the present invention, Rossitto teaches **one**-component systems. This means that the two compounds being reactive with each other are present within one single component and thus may already react with each other before their application.

Even if *Rossitto* teaches in column 8, lines 14 to 28 of U.S. Patent No. 5,977,283 that – when the two components are mixed – they can be mixed such that there is no significant reaction between the two components and that partial reaction can take place at a later stage, i. e. in the film making process, this does not suggest the present invention. The Examiner comments that the present claims do not require the presence of the components as having existed as separated entities for any particular length of time. However, this argument is not correct since in the whole specification text and also in the claims it is clearly reflected that the two reactive species are present in separate components and that mixing of the two components takes place only immediately during its application, i. e., put in other words, immediately after mixing the two reactive components the reactive mixture is applied on behalf of the respective application purposes.

According to *Rossitto*, a premature reaction within the single component can be slowed down by so-called "dry blending" techniques where the isocyanates and the polyesters are combined in solid form. However, this has nothing in common with the present invention where the two reactive species shall be stored separately in order to

prevent any reaction under control conditions. Furthermore, *Rossitto* does not suggest to the skilled practitioner to extend the processing time by the incorporation of non-isocyanate-reactive species on the basis of ethylene/vinylacetate copolymers and/or polyolefins.

Thus, *Rossitto* teaches away from the present invention, which explicitly teaches to use a **multicomponent** system wherein the two compounds being reactive with each other (namely isocyanate-reactive polymers on the one hand and isocyanates on the other hand) are present in two different granulates so that a premature reaction between these compounds before their application is prevented. Consequently, the present invention is based on a completely different principle from that of *Rossitto*.

As correctly noted by the Examiner, *Rossitto* fails to teach the presence of non-isocyanate-reactive polymers selected from the group consisting of ethylene/vinyl acetate copolymers, polyolefins and mixtures thereof. This teaching cannot be derived from *Helmeke* since that reference also refers to a **one**-component system.

Helmeke discloses a hot-melt moisture-cure polyurethane composition comprising the reaction product of at least one polyether glycol, at least one crystalline polyester polyol and at least one polyfunctional isocyanate. In contrast to the present invention, in *Helmeke* the two reactive species have already reacted with each other so that little or no free reactivities remain.

Thus, like *Rossitto*, *Helmeke* teaches away from the present invention since this reference refers to a **one**-component system wherein all reactive species are present within one single component.

The same applies to the *Yang et al.* reference (U.S. Patent No. 6,207,248). Yang teaches polyurethane-based **one**-component adhesives useful in the graphic arts area, in particular for bookbinding applications. Yang was only cited by the Examiner since it teaches the incorporation of additives on the basis of tackifying resins, thermoplastic polymers, waxes and mixtures thereof (claim 3), such as e. g. ethylene vinyl acetate copolymers (claim 6), in the polyurethane-based **one**-component adhesives. Yang uses those compounds to increase the green strength and flexibility of the bond prior to curing. That is to say, Yang refers to the ethylene/vinyl acetate copolymer with reference to the partially reacted stage. Yang does not suggest to one of ordinary skill to provide a **multi**-component adhesive system with separated entities/components comprising the different reactive species and, in this case, to extend the processing time by the presence of non-isocyanate-reactive polymers in the isocyanate-reactive component. Thus, the teaching of the Yang does not go beyond that of *Helmeke*.

It is thus submitted that a combination of *Rossitto* and *Helmeke* with our without Yang does not lead to or suggest the present invention since the first two references refer to **one**-component systems whereas according to the present invention a **multicomponent** system is provided wherein the reactive species are present in different, separate components and Yang also teaches away.

Further, it is submitted that the prior art rejection does not take into account that the substances used in the method claims are those which are covered by the claims 47 to 57 and 73 through 77. That is to say, claims 47 to 57 and 73 to 77 are acknowledged as novel and unobvious. This recitation is an element of the method claims not shown or suggested by the prior art. The rejection of the method claims does not address this issue.

In *In re Pleuddemann*, 15 USPQ 2d 1738 (Fed. Cir. 1990), the rejected claims recited a process for bonding of polymerizable material to a mineral filler and a method for priming a surface having hydroxyl functionality thereon to improve its bonding characteristics. The prior art cited therein taught the same process of bonding polymerizable material to a filler containing hydroxyl functionality using a different silane compound. The Federal Circuit reversed the rejection stating that the case resembled *In re Kuehl*, 177 USPQ 250 (CCPA 1973) holding that the use of the new composition claimed as a method for a particular use, was unobvious. Weight must be given to the materials even where those materials used in a claimed process are analogous to prior art materials, *Ex parte Glaister*, 201 U.S.P.Q. 255 (POBA, 1975) .

It is submitted the *Pleuddemann*, *Kuehl* and *Glaister* decisions are highly relevant to the patentability issue of the present method and process claims. Here, the claims drawn to the multicomponent coating and/or adhesive material were not rejected based on prior art and therefore define new and unobvious subject matter. Thus, the references cited reject the method and process claims do not disclose or suggest the multicomponent coating and/or adhesive material. As such, a process using or making the novel and unobvious material should also be new and unobvious over the prior art.

In view of the foregoing, reconsideration and allowance of the application with claims 47 to 82 are earnestly solicited.

A check in the amount \$200.00 is enclosed in payment for the addition of 1 new independent claim in excess of three.

It is believed that no additional fees or charges are required at this time in connection with the present application; however, if any fees or charges are required at


this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

The Examiner is invited to phone Applicants' undersigned attorney to resolve any remaining issues to avoid further expense or delay.

Respectfully submitted,

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